

U.S. Patent Application Serial No. 10/030,099  
Amendment dated May 6, 2004  
Reply to OA of February 9, 2004

### **REMARKS**

Claims 1-12 are pending in this application. Amendments have been proposed herein to claims 1, 4 and 6. The proposed amendments are for clarity and for consistency of the claim wording with the wording in the specification, as discussed below.

Applicants contacted Examiner Dicus on May 4, 2004, to request a personal interview, and the interview has been scheduled for May 20, 2004.

#### **Regarding claim 11**

Although claim 1-12 are listed as rejected, Applicants respectfully note that the Examiner has failed to make an explicit rejection of claim 11. In the previous Amendment dated November 7, 2003, Applicants questioned whether the Examiner meant to reject claim 11 in the rejection of claims 1-7 over Aurenty et al and Riku et al. Although the Examiner discusses claim 11 in the Response to Arguments (paragraph no. 12 of the final Office action), the rejection of claim 11 has not been clarified. Applicants respectfully request clarification of how claim 11 is rejected.

#### **General comments**

The present invention relates to a printed matter having a receiving layer for ink jet printing ink for printing variable information formed on the entire or a part of the surface of a printed paper, said surface of the printing paper having a print film containing fixed information printed by using

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a printing method selected from lithographic printing, relief printing and intaglio printing (Claim 1). According to the present invention, fixed information and variable information can be economically and efficiently printed, using the simplicity of the ink jet printing method and speed of the usual printing method. Also, by forming an ink receiving layer, beautiful images of both fixed information and variable information can be formed by both usual printing and ink jet printing, using commonly used printing paper as a substrate (page 25, line 2, of the instant specification).

In the interview scheduled for May 20, 2004, Applicants will demonstrate samples of the present invention to the Examiner.

**Claims 1 and 9 stand rejected under 35 U.S.C. §102(b) as being anticipated by USPN 4,833,486 to Zerillo for reasons of record as previously set forth in Paper No. 4. (Office action paragraph no. 1)**

Reconsideration of the rejection of claims 1 and 9 over Zerillo is respectfully requested.

Applicants traversed the rejection of claims 1 and 9 over Zerillo in the Amendment of November 7, 2003 (page 8), arguing that Zerillo disclosed only that printed ink is printed on a printing paper 32 using a lithographic plate 30, but that Zerillo did not disclose a layer corresponding to the "ink receiving layer" of claims 1 and 9.

The Examiner addresses these arguments in the Response to Arguments section, paragraph no. 8 of the Office action, stating:

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“Zerillo discloses a graphic/text (ink containing fixed image) over a plate (ink receiver). The plate **functions as an ink receiving layer because it receives ink.**” (emphasis added)

Applicants respectfully disagree with the Examiner’s position. Claim 1 recites “A printed matter having a receiving layer ... formed on the entire or part of the surface **of a printing paper**”. In the rejection as stated, the Examiner is taking Zerillo’s lithographic plate as an “ink receiver”, that is, the “receiving layer,” which is part of the “printed matter” of claim 1. However, Applicants maintain their argument that the lithographic plate is not a printing **paper**. The lithographic plate also cannot be considered to be a “layer” on a printing paper.

However, even if Zerillo’s lithographic plate were somehow considered to be the ink receiving layer, Applicants respectfully submit that the Examiner’s statement that “an ink jet printer prints graphics and text to a plate” in Zerillo does not provide the print film of claim 1, which is printed using a printing method selected from lithographic printing, relief printing and intaglio printing. No print film having fixed information (as recited in claim 1 of the present invention) is formed on the plate of Zerillo.

Applicants therefore submit that claims 1 and 9 are novel and non-obvious over Zerillo ‘486.

**Claims 1-7 stand rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 6,245,421 to Aurenty et al. in view of USPN 6,541,567 to Riku et al. for reasons of record as previously set forth in Paper No. 4. (Office action paragraph no. 3)**

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The rejection of claims 1-7 under 35 U.S.C. 103(a) over Aurenty et al. and Riku et al. is respectfully traversed.

Claim 1 of Aurenty et al. '421 describes a printing medium comprising (1) a substrate having a hydrophilic porous layer (hp layer) and (2) an ink receptive, thermoplastic image layer. The specification of Aurenty et al. describes that the image layer is formed by ink jet on the hp layer. The Examiner appears to take the hp layer in Aurenty et al. as the ink receiving layer of the present invention, and the image layer as the print film having fixed information.

The image layer in Aurenty et al, taken as the fixed information of claim 1, is printed by ink jet printing. However, in claim 1, this information is not printed by ink jet printing, but only by a method selected from lithographic printing, relief printing and intaglio printing.

Moreover, in paragraph no. 9 of the final Office action, the Examiner states:

“Applicant alleges the Examiner considered the thermoplastic image layer to be equivalent to the ink layer ... and therefore the printing plate would have no ink receiving layer. The Applicant appears to misinterpret the claim. Instant claim 1 merely calls for a receiving layer and printing fixed information as an ink layer.”

Applicants respectfully submit that the Examiner appears to overlook the fact that the printed matter of claim 1 includes “a printing paper”. In stating that the claim “merely calls for a receiving layer and printing fixed information as an ink layer,” the Examiner has ignored a portion of the claim recitation. The printing paper has both a **print film** (as amended from “ink layer”) containing fixed information and a **receiving layer** for ink jet recording ink. That is, two distinct layers on a printing paper are recited.

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Applicants also refer to the rejection as stated on page 4, lines 4 to 12, of the previous Office Action, in which the Examiner has found both the hp layer and the image layer to be ink receiving layers. Taken in this way, these do not appear to be consistent the ink receiving layer of Claim 1 of the present invention, which has a layer that merely receives ink, a layer for ink jet printing and a layer for printing variable information. Applicants note that the proposed amendment to claim 1 to recite “wherein the receiving layer receives the ink jet recording ink and variable information is formed on the receiving layer by an ink jet recording method” clarifies this point.

Applicants note that in paragraph no. 10 of the final Office action, the Examiner acknowledges that Riku et al. does not disclose the ink receiving layer and the print film (as amended from “ink layer”). Since Applicants argue that Aurenty et al. does not provide these elements of claim 1, the combination of Aurenty et al. and Riku et al. cannot provide the recited claim elements.

Applicants again note that the Examiner does not directly indicate a rejection of claim 11, but may be including it in this rejection. The Examiner comments on Applicant’s arguments regarding claim 11 from page 11 of the Amendment, in paragraph no. 11 of the final Office action. The Examiner states:

“Intermediate [process] steps are not germane to patentability in product claims.”

However, Applicants note, first of all, that claim 11 is a method claim, not a product claim. Moreover, process steps that result in a corresponding structural limitation on a product are germane to product-by-process claims.

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**Claim 12 stand[s] rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 2,245,421 to Aurenty et al. in view of USPN 6,541,567 to Riku et al. and further in view of USPN 6,509,085 to Kennedy for reasons of record as previously set forth in Paper No. 4.**  
(Office action paragraph no. 4)

Reconsideration of the rejection is respectfully requested. As noted above, Applicants argue that the combination of Aurenty et al. and Riku et al. does not provide the limitations of claims 1-7. The Examiner addresses Applicants' arguments in paragraph no. 12 of the Office action, noting that she did not use Kennedy to teach printed matter, but only to teach the method of printing using anilox and rubber layers.

Applicants therefore again submit that Kennedy does not cure the deficiency in the *prima facie* case in the rejection over Aurenty et al. and Riku et al. Again, reconsideration of the rejection is respectfully requested.

**Claim 8 stand[s] rejected under 35 U.S.C. §103(a) as being unpatentable over USPN 6,245,421 to Aurenty et al. in view of USPN 6,541,567 to Riku et al. and further in view of USPN 5,367,026 to Okude et al. for reasons of record as previously set forth in Paper No. 4.**  
(Office action paragraph no. 5)

Reconsideration of the rejection of claim 8 is respectfully requested.

Applicants continue to submit that Okude et al. does not correct the deficiencies in the *prima facie* case made using Aurenty et al. and Riku et al.

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**Claims 1 and 6-8 are rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement. (Office action paragraph no. 7)**

The Examiner states that:

“claims 1, 6, 7 and 8 do not have proper support in the original specification as filed because the specification does not provide any teaching of 1) an ink layer and 2) a receiving layer over an ink layer and/or oil based ink containing fixed information, although referred to poorly.”

Reconsideration of the rejection is respectfully requested in view of the amendment to claim 1, as follows: “said surface of the printing paper having ~~an ink layer~~ a print film containing fixed information”. That is, the term “ink layer” is amended to –print film–.

In the previous amendment, the term “print film of the ink” was replaced by “ink layer”. However, the Examiner is correct that the specification uses the term “print film” in numerous locations, but does not clearly refer to this as an “ink layer”. Applicants therefore amend the recitation back to “print film” to use wording that is fully supported by the specification.

**Claim 1 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office action paragraph no. 4, page 4)**

The Examiner states that claim 1 does not disclose where the receiving layer is in relation to the ink layer.

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Reconsideration of the rejection is respectfully requested in view of the proposed amendment to claim 1, clarifying the relationship of the elements in the claim.

Claim 1 recites that there is a receiving layer formed on the surface of a printing paper; this defines of the location of the receiving layer relative to the printing paper.

The “surface of a printing paper” is the same surface on which the ink layer (or print film) is already printed. This can be seen clearly the Examples on page 18, lines 5-8, of the specification. That is, the print film is printed first, and then the ink receiving layer is applied to the entire or part of the surface containing the print film.

Therefore, in the proposed amendment, the claim is amended in line 3 to recite “said surface of the printing paper”. This clarifies that the receiving layer is located over the print film on the surface of the printing paper.

Applicants have also amended claim 1 to recite: “wherein the receiving layer receives the ink jet recording ink and variable information is formed on the receiving layer by an ink jet recording method”. This amendment clarifies that the variable information is formed by an ink jet recording method.

**Claim 4 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. (Office action paragraph no. 5, page 4)**



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The Examiner indicates that the phrase “wherein the receiving layer comprising an ink-absorbing resin as its main ingredient is a receiving layer for an ink jet recording ink further containing a filler” is unclear.

Reconsideration of the rejection is respectfully requested in view of the proposed amendment to claim 4. The amendment to claim 4 simplifies the wording of the claim, reciting that the receiving layer in claim 4 “further contains a filler”.

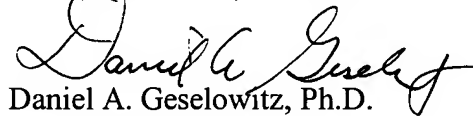
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If, for any reason, it is felt that this application is not now in condition for allowance, the Examiner is requested to contact Applicant's undersigned agent at the telephone number indicated below to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed, Applicant respectfully petitions for an appropriate extension of time. Please charge any fees for such an extension of time and any other fees which may be due with respect to this paper, to Deposit Account No. 01-2340.

Respectfully submitted,

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